

PRE-APPEAL BRIEF REQUEST FOR REVIEW

(filed with the Notice of Appeal)

Docket Number 034691/313122

Application Number: 10/596,629

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First Named Inventor: Karlheinz Herbold

Art Unit: 3725

Examiner: Miller, Bena B

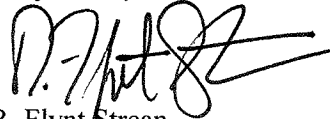
Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

Respectfully submitted,



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Attachment
Reasons for Requesting Pre-Appeal Brief Request for Review

Applicants are requesting a Pre-Appeal Brief Request for Review on the basis that the Examiner has failed to show that the cited art, alone or in combination, teaches or suggests each and every element as set forth in the claims. In addition, Applicants submit that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established.

I. Introduction

Claims 1 and 24-38 are pending in the present application. Claims 1 and 24-38 currently stand rejected under a Final Office Action dated July 31, 2008. Specifically, Claims 1 and 24-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,467,931 to Dodd (“the Dodd patent”), in view of U.S. Patent No. 464,592 to Staver (“the Staver patent”).

II. The Present Application

In various embodiments, the present invention relates to a disk mill having two grinding disks that are each formed as a ring having a central hole and are disposed so as to be substantially parallel to each other. Each disk is capable of rotating with respect to the other, such that in some embodiments, one of the grinding disks is disposed so that it cannot rotate and the other grinding disk is disposed so that it can rotate, however in other embodiments, the two grinding disks may both rotate. The grinding disks comprise first and second working surfaces—the first working surface located in an inner area and the second working surface located in an outer edge section. The first working surfaces are directed towards one another and are spaced apart thereby forming a working space in the area adjacent the hole. The first working surfaces run conically towards one another in an outward direction and narrow the working space. The second working surfaces are substantially parallel to one another forming a slight space between the grinding disks. The first and second working surfaces include straight cutting teeth that have an approximate saw-tooth cross section. The cutting teeth of the first and second working surfaces of the same grinding disk run in the same direction—obliquely oriented to a radial direction. The cutting teeth of the second working surfaces are inclined more sharply than the cutting teeth of the first working surfaces. In such a manner, the exposure time is lengthened in the outer edge section, thus resulting in improved grinding.

Of the pending claims under review, Claim 1 is the sole independent claim and is reproduced below (with emphasis added).

1. A disk mill comprising:

two grinding disks each formed as a ring with a central hole, with the disks being disposed so as to be essentially parallel to one another, and being capable of rotating with respect to one another about a common axis which extends through the central holes of the disks, and which comprise:

first working surfaces in an inner area which are directed towards one another, are spaced apart from one another thereby forming a working space in the area adjacent the hole, run conically towards one another in the outwards direction, and narrow the working space; and

second working surfaces formed in an outer edge section so as to be parallel to one another and with at least slight spacing from one another,

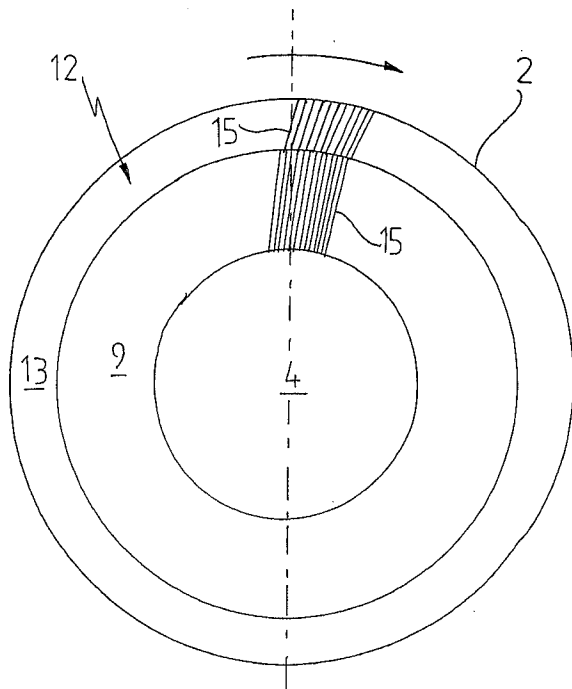
wherein the first working surfaces as well as the second working surfaces are provided with straight cutting teeth, wherein the cutting teeth have an approximately saw-tooth cross section, wherein the cutting teeth of the first and second working surfaces of the same grinding disk run in the same direction obliquely to the radial direction, and wherein the cutting teeth of the second working surfaces are inclined more sharply than the cutting teeth of the first working surfaces.

III. Analysis of the Claim Rejections

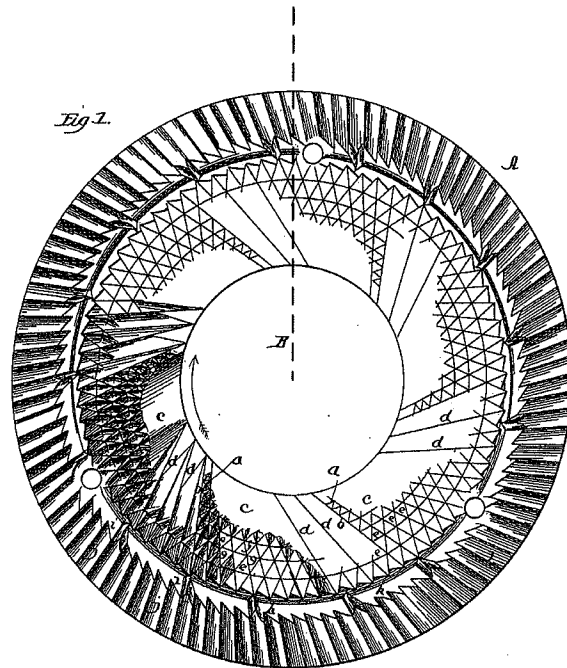
Claims 1 and 24-38 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the Dodd patent, in view of the Staver patent. In particular, the Examiner asserts that the Dodd patent teaches all of the elements of the claimed invention except the cutting teeth of the second working surfaces being inclined more sharply than the cutting teeth of the first working surfaces. Applicants submit that the neither the Dodd patent, nor the Staver patent, alone or in combination teaches or suggests each of the claim limitations of independent Claim 1. Additionally, Applicants submit that because it would not be obvious to combine the Dodd and Staver patents in the manner asserted by the Examiner, a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established.

In particular, the Examiner asserts that the Staver patent teaches “a portion of the workings [sic] surface (d) with cutting teeth that are inclined more sharply than the cutting teeth of another portion of the working surface (j; fig. 4 and 5).” Final Office Action, pages 2-3. In the Response to Arguments section of the Final Office Action, the Examiner indicates that the Examiner considers the first working surface as element j of the Staver patent, and the second working surface as element d of Staver patent. Final Office Action, page 4.

For comparison, **Fig. 3** from the current application is reproduced below on the left and **Fig. 1** from the Staver patent is reproduced below on the right. A dashed line has been added to the figure from the Staver patent for reference.



Current Application Fig. 3



Staver Patent Fig. 1

Referring to **Fig. 3** of the current application, element 9 refers to the first working surfaces (inner surfaces) in an area adjacent the central hole 4, and element 13 refers to the second working surfaces (outer surfaces). As can be seen by example at the top of the figure, the cutting teeth 15 of the second working surfaces (outer surfaces) 13 are more inclined than the cutting teeth 15 of the first working surfaces (inner surfaces) 9. Referring to **Fig. 1** from the Staver patent, the Examiner asserts that surface d represents the second working surface and that surface j represents the first working surface, and that the teeth of surface d are inclined more sharply than the teeth surface j.

However, as can plainly be seen in **Fig. 1** from the Staver patent, surface d is in an inner area of the grinding ring, and surface j is on an outer area of the grinding ring. Thus, the Examiner is ignoring the positional limitations of Claim 1 as this orientation is the complete opposite of the orientation recited by the claim, where the second working surfaces (with more inclined teeth) are recited as being formed in an outer edge section of the grinding disk, and the first working surfaces (with less less inclined teeth) are recited as being in an inner area of the grinding disk, adjacent the hole. Therefore, Applicants submit that the Staver patent does not teach or suggest the cutting teeth of the second working surfaces (outer surfaces) being inclined more sharply than the cutting teeth of the first working surfaces (inner surfaces). Applicants further submit that the deficiencies of the Staver patent are not cured by the Dodd patent, nor does the Final Office Action assert as much.

Additionally, Applicants note that the Examiner has failed to identify a legitimate reason for combining the references. In *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (U.S. 2007), the Supreme Court acknowledged the importance in making obviousness determinations of identifying “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed invention does.” *KSR*, 127 S. Ct. at 1731. In the instant case, the Examiner has attempted to piece together the claimed invention by citing the Dodd and Staver patents, but has failed to identify a legitimate reason for combining the teachings of these references to arrive at the claimed invention. Moreover, Applicants submit that one of ordinary skill in the art would not be prompted to combine these references.

In particular, it appears that the Examiner wishes to argue that the first working surface **j** of the Staver patent could be positioned in an inner area, and the second working surface **d** of the Staver patent could be positioned on the outer area (i.e., reversed from the orientation clearly shown in **Fig. 1** of the Staver patent). However, aside from the fact that such an interpretation would clearly ignore the positional limitations included in Claim 1, Applicants submit that the Staver patent teaches away from such an orientation. As stated in the specification of the present application, because the cutting teeth of the second working surfaces are inclined more sharply than the cutting teeth of the first working surfaces, the exposure time is lengthened in the outer edge section. However, because the teeth of surface **d** are inclined more sharply than the teeth of surface **j**, the exposure time is lengthened in the *inner section* of the Staver patent. As a result, the Staver patent describes the use of grooves, drifts, and an annular groove **h** between the inner and outer sections to receive grinded material. Staver patent, page 1, lines 86-96. One of ordinary skill in the art would have no legitimate reason for modifying the Staver patent in the manner the Examiner proposes and to combine it with the Dodd patent to arrive at the claimed invention.

Given the lack of evidence of a reason to combine the cited references, it appears that the Examiner has engaged in impermissible “hindsight reconstruction” in formulating the present rejection. See, *Graham*, 383 U.S. at 36 (stating the importance of guarding against “slipping into hindsight and...resisting [the] temptation to read into the prior art the teachings of the invention in issue”). Therefore, in establishing obviousness, it is improper “to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Accordingly, the lack of a *bona fide* reason to combine the cited references to arrive at the claimed invention provides further evidence that Claim 1 is not obvious.

Applicants maintain that the Examiner has impermissibly used the claims as an instruction manual to find prior art that might render the claims obvious, rather than addressing the question of whether it would have been obvious to combine the Dodd and Staver patents without having access to the instant application to arrive at the claimed invention as a whole. As stated by the Federal Circuit,

[A]lthough *Graham v. John Deere Co.*, 383 U.S. at 17, 148 USPQ at 476, requires that certain factual inquiries, among them the differences between the prior art and the claimed invention, be conducted to support a determination of the issue of obviousness, the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of **the claimed invention as whole**, not merely the differences between the claimed invention and the prior art.

Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 221 USPQ 1025, 1033 (Fed. Cir. 1984) (emphasis added). Thus, Applicants submit that a *prima facie* case of obviousness under 35 U.S.C. § 103(a) has not been established, and that Claim 1 is patentable over the cited references.

Because neither the Dodd patent nor the Staver patent, alone or in combination teaches or suggest each of the claim recitations of independent Claim 1, and because the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), Applicants submit that independent Claim 1 is patentable over the cited references. Because Claims 24-38 depend from independent Claim 1, Applicants further submit that the remaining claims are also patentable over the cited references.

III. Conclusion

Applicants submit that neither of the cited references, alone or in combination, teaches or suggests each and every element of independent Claim 1 of the present application. Additionally, Applicants submit that the Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 1 under 35 U.S.C. § 103(a). As a result, Applicants submit that independent Claim 1 is patentable over the cited references, alone or in combination. Because the remaining claims depend from this claim, Applicants further submit that all the pending claims are patent over the cited references, alone or in combination.

Accordingly, for at least all the reasons stated above, Applicants respectfully submit that the rejections of Claims 1 and 24-38 should be reversed.